

## IV. Remarks.

The Examiner entered the following rejections.

1. Claims 9-18 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is amended.

Claim 9 reads on Fig. 3.

2. Claim 13, as understood, is rejected under 35 USC 102(b) as being anticipated by Adachi et al. (5,289,813).

The analysis with respect to anticipation requires that a strict standard be satisfied. The standard extends beyond simply identifying elements in the reference that are then compared to the claim, it requires that every element be present arranged as in the claim.

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir.), cert. denied, 493 U.S. 853, 110 S.Ct. 154, 107 L.Ed.2d 112 (1989). An invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. Perkin-Elmer Corp v. Computervision Corp., 732 F.2d at 894, 221 USPQ at 673 (Fed.Cir.); Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed.Cir.1983), cert. denied, 465 U.S. 1026, 104 S.Ct. 1284, 79 L.Ed.2d 687 (1984). The identical invention must be shown in as complete detail as is contained in the patent claim. Jamesbury Corp. v. Litton Industrial Products, Inc., 756 F.2d at 1560, 225 USPQ at 256 (Fed.Cir.).

Adachi discloses a mechanical supercharger includes a housing, first, second and third shafts rotatably supported on the housing, respectively, a first timing gear disposed on the first shaft, a second timing gear disposed on the second shaft and engaged with the first shaft timing gear, a first rotor disposed on the first shaft, a second rotor disposed on the second shaft and engaged with the first rotor, a first pulley disposed on one end of the first shaft, an electromagnetic clutch interposed between the first shaft and the first pulley and being selectively intermittent a transmission of driving force between the first shaft and the first pulley, a reduction gear disposed on one end of the third shaft through an one-way clutch and engaged with the second timing gear, a second pulley disposed on the other end of the third shaft and a driving force transmission means for transmitting driving force of engine to the first and second pulleys so that the first and second pulleys are simultaneously rotated in the same direction.

Applicant respectfully asserts that the reference does not fully disclose the claimed invention. Namely, the claim includes "a one-way clutch comprising a damper". The damper limitation is not taught by Adachi. Instead Adachi only teaches a one-way clutch (32) which is directly attached to a shaft (24). No teaching is made concerning a damper.

The inventive damper (68, see Fig. 3 and application page 5, lines 14-25) and (330, see Fig. 10 and application page 13, lines 16-20) is used to damp engine (crankshaft) torsional vibrations which may otherwise damage the one-way clutch.

In the absence of teaching directed to a damper, Adachi fails to anticipate claim 13. Applicant requests the rejection be withdrawn.

3. Claims 14, 15 and 17, as understood, are rejected under 35 USC 103(a) as being unpatentable over Adachi et al. in view of JP (11-280873).

Claims 14, 15 and 17 are dependent from claim 13.

4. Claims 9, 11-12, as understood, are rejected under 35 USC 103(a) as being unpatentable over McRae (2,911,961) in view of JP (11-280873).

A rejection based on 35 U.S.C. § 103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. *Interconnect Planning Corp. v. Fiel*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed.Cir. 1985); *In Re Corkhill*, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed.Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. *Environmental Designs v. Union Oil Co. of Cal.*, 713 F.2d 693, 698 (Fed.Cir. 1983) (other citations omitted).

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A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. *American Hoist & Derek Co. v. Sowa & Sons, Inc.*, 220 U.S.P.Q. (BNA) 763, 771 (Fed.Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit recently noted, “[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *Ecolochem, Inc. v. Southern Calif. Edison*, 56 U.S.P.Q. 2d 1065, 1073 (Fed.Cir. 2000). There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999). This is because “combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability.” *Id.* Accordingly, to establish a rejection under 35 U.S.C. § 103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir. 1998).

Obviousness also entails a review of the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1996) namely, 1) determining the scope and content of the prior art, 2) ascertaining the differences between the claimed invention and the prior art, and 3) resolving the level of ordinary skill in the pertinent art.

In a recent case where the patent in suit was found invalid, the Supreme Court observed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KRS International Co. v. Teleflex Inc.* 127 S.Ct. 1727, 82 USPQ 2d 1385 (2007). The court stated:

“Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (emphasis added) *Id.* at 1741.

As to claim 9, the Examiner observes that McRae does not teach the inertial member and the damping member. JP 11-280873 is cited for the proposition of providing these components. However, JP 11 does not satisfy the following limitation, namely,

“a one-way clutch comprising a damper, the one-way clutch directly mounted to the rotating shaft”

Figure 4 of JP 11 teaches that the damper (6) is disposed between the hub (1) and the pulley (2). The damper of JP 11 is not disposed between the one-way clutch (3) and the pulley (2).

On the other hand the instant invention comprises the damper (68) disposed between the pulley (66) and the one-way clutch (42). See application Fig. 3, page 5, lines 14-25. The instant invention having the damper (68) between the one-way clutch (42) and the pulley (66) allows for a “soft-landing” for the one-way clutch which enhances life expectancy during load reversals.

Therefore, JP 11 does not teach a “one-way clutch comprising a damper” as claimed. Instead, JP 11 teaches a pulley comprising a damper, with a one-way clutch included in a larger assembly. See the translation provided by the Examiner with the reference, namely, “a rubber damper (6) for attenuating the vibration (shaft resonance) generated from the rotary shaft (10).” The damper (6) is on “both sides of the oneway clutch (3)”, but is not otherwise described as a part of the one-way clutch. It appears the damper is used to attenuate vibrations flowing between the pulley (2) and the shaft (10). No mention is made of the one-way clutch (3) in terms of the effect or structure of the damper as a part of the one-way clutch. This is consistent since the damper in JP 11 does not appear to be operationally disposed to affect operation of the one-way clutch; instead, the one-way clutch is directly connected between the shaft (10) and the pulley (2).

Hence, there is no incentive to combine these references since the noted limitation is not taught as claimed.

Claims 11 and 12 depend from claim 9.

5. Claim 10, as understood, is rejected under 35 USC 103(a) as being unpatentable over McRae (2,911,961) in view of JP (11-280873) as applied to claim 9 above, and further in view of JP (59-47528).

Claim 10 depends from claim 9.

V. Fees.

Any fees payable for this response may be deducted from deposit account 070475 in the name of the Gates Corporation.

Thank you for your attention to this case.

Sincerely,



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